

REMARKS

This paper is submitted in response to the pending Office Action mailed on May 4, 2006. Because this Response is submitted with a Petition for a two month Extension of Time, and the Office is directed to charge **Deposit Account No. 23-1925 (08285/288-1)** in the amount of \$450.00 for the fee set forth under 37 C.F.R. §1.17(a)(1), this Response is timely filed.

I. STATUS OF THE CLAIMS

Prior to this Response, claims 1 to 28 were pending and at issue. By this Response, none of the claims have been amended, no new claims have been canceled, and no new claims have been added. Thus, claims 1 to 28 remain pending and at issue in this application.

While Applicants believe that no additional fees are due in connection with this application, Applicants direct the Office to charge **Deposit Account No. 23-1925 (08285/288-1)** for any fees deemed owed during the pendency of this application, excluding the issue fee.

II. CLAIMS REJECTIONS

The Office Action rejects: claims 1 to 4, 6, 8 to 11, 13 to 17 and 19 to 28 under 35 U.S.C. §103 as obvious¹ over U.S. Patent No. 5,930,350 to Johnson ("*Johnson*") in view of U.S. Patent No. 5,745,553 to Mirville et al. ("*Mirville*") and further in view of U.S. Patent No. 6,160,855 to Tatchell et al. ("*Tatchell*"); and claims 5, 7, 12 and 18 under 35 U.S.C. §103 as obvious over *Johnson* in view of *Tatchell* and further in view of U.S. Patent No. 6,076,121 to Levine ("*Levine*").

¹ To establish a *prima facie* case of obviousness, three basic criteria must be met.

- (a) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- (b) Second, there must be a reasonable expectation of success.
- (c) Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143 - §2143.03 for decisions pertinent to each of these criteria.

A. CLAIM REJECTIONS UNDER 35 U.S.C. §103

Applicants respectfully traverse the obviousness rejections based on the newly cited *Johnson* reference and one or more of the previously cited references: *Mirville*, *Tatchell* and *Levine*. In particular, Applicants submit that the cited references, either alone or in combination, do not teach or suggest all of the claim limitations and do not provide the necessary suggestion or motivation to make the suggested modification. Thus, Applicants submit that these references do not establish a *prima facie* case of obviousness.

Independent claims 1, 8 and 14 recite, in part, a method and system for placing a call to a previously called party that generally includes: (i) storing a calling history for a calling party, where the calling history is generated using calling party identification information relating to the calling party; (ii) receiving the calling party identification information relating to the calling party along with a dialed service code; and (iii) retrieving and communicating a list of previously called parties to the calling party upon receiving both the dialed service code and the calling party identification. In other words, as a calling party places a call, the calling party identification information is utilized to create a call history that lists each of the parties the calling party has previously called. This list of previously called parties can be accessed by **the calling party** when a dialed service code and the calling party identification information are provided.

As previously stated, none of the cited references discloses or even suggests a system and method that includes the elements recited in claims 1 to 28 much less provides the necessary suggestion or motivation to modify the cited references to provide the method and system recited in claims 1 to 28. *Johnson* simply discloses a system and method for automatically configuring a speed dial system for a called party. *Johnson* does not, at least, disclose storing a calling history for a calling party, retrieving and communicating **a list of previously called parties** to the calling party upon receiving both the dialed service code and the calling party identification.

Moreover, and contrary to the characterization provided on pages 2 and 3 of the pending Office Action, the speed dial of *Johnson* does not list "called numbers and/or names associated with the call numbers that may be retrieved from the an address book database using [the] caller's ID". See pending Office Action at page 2, line 17 to page 3, line 1. Rather, the system of *Johnson* generates a list and creates a

speed dial of received communications, i.e., a phone call, phone message, E-mail message, soft facsimile and print job, based on the information associated with the calling party or sender of the communication. As clearly stated in the *Abstract* of *Johnson*:

[...] Information (e.g., telephone number) about the [calling party] is retrieved from an address book database using the [calling party's caller ID]. A speed dial setting is assigned and stored in a speed dial database using the sender's information [calling party's information]. The system permits the [called party] of the distribution to automatically dial the [calling party] by invocation of the speed dial setting. (Annotations added.)

Stated another way, the system and method of *Johnson* gathers and creates a list of calling parties based on a calling party identification associated with each of the parties. The items on this list are, in turn, assigned to a speed dial to allow the **called party to contact the calling party (the sender) without looking up their information or number**. Thus, *Johnson* is configured and operates almost diametrically opposite to the method and system recited in claims 1 to 18 which allows the calling party (i.e., the sender and not the called party) to retrieve a list of parties they previously called.

As previously discussed in the Applicants' PRE-APPEAL BRIEF REQUEST FOR REVIEW dated January 12, 2006, *Mirville* discloses an on-demand network service option; *Tatchell* discloses methods of call screening; and *Levine* discloses methods of network addressing and translation. Thus, because none of the cited references, either alone or in combination, teaches or even suggests each and every element recited in the claims and *Johnson* teaches away from a system in which the calling party can retrieve a list of parties they previously called², the cited references cannot be the basis for establishing a *prima facie* case of obviousness.

² Recall, the called party of *Johnson* can speed dial the calling party but the calling party does not maintain a list of parties they have called.

III. CONCLUSION

For the foregoing reasons, Applicant respectfully requests withdrawal of the pending obviousness rejections and submits that the above-identified patent application is now in condition for allowance and earnestly solicits reconsideration of same. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting prosecution of this application.

Respectfully submitted,

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Dated: **October 4, 2006**